

REMARKS

State of the Claims

Claims 1-13 and 15-18, and 22-26 are pending. Claims 24-26 have been canceled without prejudice. No other amendments to the claims have been made.

Information Disclosure Statement

The Examiner states that the IDS filed on October 1, 2001 fails to comply with the provisions of 37 CFR §§1.97, 1.98 and MPEP § 609 because the three Sample references do not include dates, i.e., dates of their first marketing.

Applicants note that they are unable to provide the “publication” dates of the non-patent references because each of the references is a sample of competitive product having its origin outside of the control of Applicants or Applicants’ Assignee, namely, Procter & Gamble. Further, Applicants’ are not privy to the internal release dates of competitive product. That being said then, the only “control” or knowledge that Applicants can reasonably be expected to hold is to ascertain whether the listed products existed in the public forum before the filing date of Applicants’ application. Applicants determined that the listed products were in fact on sale before Applicants’ filing date and in proper compliance with 37 C.F.R. § 1.56 listed the products in Applicants’ Information Disclosure Statement.

Accordingly, Applicants believe that their IDS should be accepted and deemed proper by the Examiner.

35 U.S.C. § 112 Rejection

Claim 22 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable one of skill in the art to make or use the invention. Specifically, the Examiner asserts that the term “engagement span” is not described by the specification, nor does the specification teach how to calculate the engagement span.

Applicants respectfully disagree with the Examiner. Applicants contend that the engagement span is described both in the specification and in the figures of the specification. For example, Applicants describe the engagement span in the disclosure itself.¹ Therein, the engagement span is described as calculable from certain percentages of the vertex span that is

¹ Applicants’ Specification at page 9, lines 16-23.

useful to help obtain the optimal orientation of the axis of curvature of the chip.² The vertex span is also properly defined and disclosed in the specification.³

Furthermore, the location and orientation of the engagement span are shown in Figures 3a, 3b, 3c, and 3d of Applicants' specification. In each figure, the engagement span is shown as being geometrically similar to the vertex span. Also, Applicants respectfully assert that 90% of any calculated number (i.e., the vertex span) is readily calculable, and one of skill in the art would know how to calculate 90% of that number; namely, through multiplication of 0.90 times the vertex span. Thus, the engagement span is in fact described and defined and its calculation is readily ascertainable by one of skill in the art; i.e., "the engagement span is 90% of the vertex span..."⁴

In addition, the Examiner seems to be contradictory in his statements regarding the engagement span. First, the Examiner states (for the purposes of the 35 U.S.C. § 112, first paragraph, rejection) that "the specification does not describe what an engagement span is, or how it is calculated."⁵ Also, the Examiner asserts "it is not clear how it [the engagement span] was calculated."⁶ However, later in the office action, the Examiner ascribes the existence of Applicants' engagement span to several of the references cited against Applicants' claims, e.g., Hreschak (U.S. Design Patent No. 212,070), Smietana (U.S. Patent No. 4,915,964), Morales (U.S. Design Patent No. 383,589), and Tirillo (U.S. Patent No. 5,997,921). As an example the Examiner states the following:

Hreschak teaches a snack product comprising a body curved about a first axis thus forming a dip containment region with an open end, sides which are not parallel to the axis, restriction of movement to the sides and rear, [and] an engagement span which is 90% of the vertical span[.]⁷ [Emphasis added.]

Applicants respectfully assert that it is improper for the Examiner to disavow the efficacy of Applicants' description of their engagement span for one type of rejection (i.e., 35 U.S.C. § 112) and then in the next breath use Applicants' description of their engagement span (just like Applicants have asserted that one of skill in the art would use it) to reject Applicants' claims in another type of rejection (i.e., 35 U.S.C. § 102(b), (e) and 35 U.S.C. § 103(a)).

Applicants respectfully assert that the Examiner cannot have it both ways. He cannot in one instance assert that Applicants' engagement span is improperly described, incalculable and

² Id. at page 9, lines 21-24; (i.e., "The engagement span is about 90% of the vertex span, more preferably about 70%, most preferably about 50%...")

³ Id. at page 9, lines 18-23.

⁴ Id. at page 9, lines 21-24

⁵ Examiner's Office Action, dated October 21, 2003, page 2.

⁶ Id.

⁷ Id. at page 4.

therefore unknowable and then in the next instance calculate Applicants' engagement span upon the prior art and use his calculations to reject Applicants' claims. To do such is improper and, in Applicants view, constitutes an improper use of the Examiner's personal knowledge.

Applicants therefore respectfully request reconsideration and allowance of Claim 22 over the Examiner's 35 U.S.C. § 112, first paragraph, rejection.

Claim 22 stands rejected under 35 U.S.C. § 112, second paragraph. The Examiner again asserts that it is not clear what an engagement span is or how it is calculated.

For all of the reasons cited above in the previous rejection, Applicants respectfully assert that the Examiner's rejection is improper. Therefore, Applicants request reconsideration and allowance of Claim 22 over the Examiner's 35 U.S.C. § 112, second paragraph, rejection.

35 U.S.C. § 102 Rejection

Claims 1-4, 9, 12, 16-17 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hreschak (U.S. Design Patent No. 212,070).

The Examiner states that Hreschak '070 teaches a snack product comprising a body curved about a first axis thus forming a dip containment region with an open end, sides that are not parallel to the axis, restriction of movement to the sides and rear, an engagement span that is 90% of the vertical span, the axis being perpendicular to the open end, sidewalls, a restricted end that is less than 75% of the open width, a vertical taper of less than 45°, and a varying radius of curvature along its length (see Figures 1-4).

According to MPEP § 2131 a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. The elements must be arranged as required by the claim.

The Examiner states that the recitation "stackable" has not been given patentable weight because the recitation occurs in the preamble. He further states that a preamble is generally not accorded patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness, but instead steps or structural limitations are able to stand alone. The Examiner concludes by stating "regardless, nearly any snack product, including Hreschak ['070] would be capable of being stacked in some manner, for instance in a pile."

Applicants assert that the Examiner has improperly not considered Applicants' preamble and also has misapplied legal precedent as a basis for that lack of consideration. A

claim preamble has the import that the claim as a whole suggests for it.⁸ If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is necessary to give life, meaning, and vitality to the claim, then the claim preamble should be construed as if in the balance of the claim.⁹ And further, any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.¹⁰

Herein, the term “stackable”, which was previously added to the preamble of Claim 1 is a term that should have been considered by the Examiner because it further limits the scope of Claim 1. Applicants assert that the “stackable” limitation is necessary to give life, meaning and vitality to the claim and in particular further describes the snack piece; i.e., exactly the type and kind of snack piece--“a stackable, uniform snack piece.” The inclusion of the term “stackable” is well-supported throughout the specification and should be fully considered as part of Claim 1 and a limitation to Claim 1.

Furthermore, although Applicants made these same arguments in their Preliminary Amendment dated August 15, 2003, the Examiner has failed to respond to their merit in the latest office action dated October 21, 2003. Instead, the Examiner has merely repeated, verbatim, his previous rejection without comment thereto.

Regarding Hreschak ‘070, the snack pieces thereof are not stackable or meant to be stacked. The folded finger portion 34 that resides at the end of Hreschak’s food product would render stacking of his product impossible, because the folded finger portion 34 could not in fact be stacked one on top of another.¹¹ In contrast, Applicants’ entire snack piece can be stacked and placed into a nested arrangement for packaging into a container designed for such an arrangement.¹² The Examiner attempts to avoid this distinction by asserting that Hreschak ‘070 might be “stacked into a pile”. However, Applicants respectfully assert that a pile is not a stacking as shown and taught by Applicants’ specification, nor is a pile of un-stackable snack pieces (e.g., Hreschak ‘070) Applicants’ stack of snack pieces as known to one of skill in the art.

⁸ Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995).

⁹ Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

¹⁰ Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989).

¹¹ U.S. Design Patent No. 212,070 (Hreschak) at Figure 5.

¹² Applicants’ Specification at page 16, lines 19-24; and Figures 12, 14 and 15.

To wit, Applicants' stackable feature is not taught or shown by Hreschak '070; nor is it inherently derived from Hreschak's figures or disclosure. Also, the Examiner does not point to any teaching within Hreschak '070 that shows that the snack pieces of Hreschak '070 can be stacked. As such, it is a missing element that cannot be properly included in a rejection against Applicants' claims based upon anticipation. Furthermore, Applicants assert that if the Examiner knows of a manner in which the snack pieces of Hreschak '070 may be stacked, it is wholly within the Examiner's personal knowledge and is therefore improper.

In addition, Applicants expressly do not concede that Hreschak '070 teaches Applicants' engagement span. In one instance in the Examiner's office action dated October 21, 2003, he states that Applicants' engagement span is incalculable and that it is not clear as to what it is. In the next instance, however, he seemingly calculates Applicants' engagement span and then applies such to Hreschak '070. Furthermore, the Examiner applies Applicants' engagement span to Hreschak '070 without indicating how such was calculated. Applicants therefore believe that in the Examiner's application of their engagement span to Hreschak '070, the Examiner has used his personal knowledge to arrive at such since he asserts that Applicants' engagement span is "not clear" and incalculable.

Therefore, Applicants respectfully request that the Examiner provide an affidavit that produces one or more references that supports the Examiner's assertions; i.e., 1) the stackability of Hreschak's snack pieces and 2) the use of Applicants' engagement span. If Applicants traverse an assertion made by the Examiner, the Examiner should cite a reference in support of his position.¹³ When a rejection is based on facts within the personal knowledge of the Examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the Applicant, by an affidavit from the Examiner.¹⁴ If the Examiner fails to provide a suitable affidavit that bolsters his reasons for rejection herein, the rejection should be withdrawn.

Applicants therefore respectfully request reconsideration and allowance of Claims 1-4, 9, 12, 16-17 and 22 over the Examiner's 35 U.S.C. § 102(b) rejection.

Claims 1-7, 9, 11-13, 15-18 and 22-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Smietana (U.S. Patent No. 4,915,964).

The Examiner states that Smietana '964 restricts dip in at least two directions and that the reference provides an engagement span less than 90% of the vertical span.

¹³ 37 CFR § 104(d)(2); MPEP 2144.03.

¹⁴ Id.

Applicants respectfully disagree with the Examiner's assertions. First, Figure 1 of Smietana '964 shows a possible restriction of dip in only one direction, namely, at the narrow conical end. Else, there is no second restrictive end, and the Examiner has not described or pointed to such. In fact, according the figures of Smietana '964, only two ends exist--the narrow conical end and the opposing open end. Smietana does not teach a dip restriction in at least two directions. This element is therefore missing.

Furthermore, Applicants expressly do not concede that Smietana '964 teaches Applicants' engagement span. In one instance in the Examiner's office action dated October 21, 2003, he states that Applicants' engagement span is incalculable and that it is not clear as to what it is. In the next instance, however, he seemingly calculates Applicants' engagement span and then applies such to Smietana '964. Furthermore, the Examiner applies Applicants' engagement span to Smietana '964 without indicating how such was calculated. Applicants therefore believe that in the Examiner's application of their engagement span to Smietana '964, the Examiner has used his personal knowledge to arrive at such since he ardently asserts that Applicants' engagement span is "not clear" and incalculable.

Therefore, Applicants respectfully request that the Examiner provide an affidavit that produces one or more references that supports the Examiner's assertions; i.e., the use of Applicants' engagement span. If Applicants traverse an assertion made by the Examiner, the Examiner should cite a reference in support of his position.¹⁵ When a rejection is based on facts within the personal knowledge of the Examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the Applicant, by an affidavit from the Examiner.¹⁶ If the Examiner fails to provide a suitable affidavit that bolsters his reasons for rejection herein, the rejection should be withdrawn.

Applicants therefore respectfully request reconsideration and allowance of Claims 1-7, 9, 11-13, 15-18 and 22-26 over the Examiner's 35 U.S.C. § 102(b) rejection.

Claims 24-26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Bierschenik, et al. (U.S. Patent No. 6,338,606).

Claims 24-26 have been canceled without prejudice. The Examiner's rejection is therefore obviated.

¹⁵ 37 CFR § 104(d)(2); MPEP 2144.03.

¹⁶ Id.

Claims 1-4, 9, 12 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Morales (U.S. Design Patent No. 383,589).

The Examiner asserts that Morales teaches a stackable snack piece having a restricted end and an engagement span less than 90% the vertical span.

Applicants respectfully assert that Morales '589 does not show their snack piece being stacked. In fact, nothing in Morales '589 provides a showing of stacking. Applicants therefore believe that the Examiner's assertion of stacking by Morales '589 exists within his personal knowledge, which is now therefore being contested. Also, Applicants consider that the Examiner's assertion that Morales '589 provides an engagement span is also within the personal knowledge of the Examiner since he disclaims the ability to calculate such in the Office Action dated October 21, 2003 but apparently has ascribed an engagement span to Morales '589 by some other means not related to Applicants' description and definition of their engagement span.

Therefore, Applicants respectfully request that the Examiner provide an affidavit that produces one or more references that supports the Examiner's assertions; i.e., 1) the stackability of Morales '589 and 2) the use of an engagement span calculation to Morales '589. If Applicants traverse an assertion made by the Examiner, the Examiner should cite a reference in support of his position.¹⁷ When a rejection is based on facts within the personal knowledge of the Examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the Applicant, by an affidavit from the Examiner.¹⁸ If the Examiner fails to provide a suitable affidavit that bolsters his reasons for rejection herein, the rejection should be withdrawn.

Applicants therefore request reconsideration and allowance of Claims 1-4, 9, 12 and 22 over the Examiner's 35 U.S.C. § 102(b) rejection.

Claims 1-4, 9, 12 and 22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tirillo (U.S. Patent No. 5,997,921).

The Examiner asserts that Tirillo '921 teaches a stackable snack piece comprising an engagement span less than 90%. Applicants expressly disclaim these assertions. Nothing in Tirillo '921 teaches or shows stacking of their taco shell. Also, Tirillo '921 does not teach or show an engagement span of any sort and certainly not one less than 90%. Applicants believe that these two assertions derive from the Examiner's personal knowledge.

¹⁷ 37 CFR § 104(d)(2); MPEP 2144.03.

¹⁸ Id.

Therefore, Applicants respectfully request that the Examiner provide an affidavit that produces one or more references that supports the Examiner's assertions; i.e., 1) the stackability of Tirillo '921 and 2) the use of an engagement span calculation to Tirillo '921. If Applicants traverse an assertion made by the Examiner, the Examiner should cite a reference in support of his position.¹⁹ When a rejection is based on facts within the personal knowledge of the Examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the Applicant, by an affidavit from the Examiner.²⁰ If the Examiner fails to provide a suitable affidavit that bolsters his reasons for rejection herein, the rejection should be withdrawn.

Applicants therefore request reconsideration and allowance of Claims 1-4, 9, 12 and 22 over the Examiner's 35 U.S.C. § 102(b) rejection.

35 U.S.C. § 103 Rejection

Claims 10-11 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hreschak '070. The Examiner notes that Hreschak '070 does not teach a length of 30 - 110 mm, a radius of curvature of 15 - 500 mm, or an open width of 15 - 75 mm.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations. (MPEP § 2142).

Applicants point out that not only does Hreschak '070 not teach Applicant's radius of curvature ranges, but also, Applicants contend that Hreschak '070 does not teach or suggest Applicant's snack piece having a body curved about a first axis, the curvature of the body forming a dip containment region. In fact, the snack piece of Hreschak '070 shows merely a flattened main surface with a pinched, elevated portion at one end of the snack piece and no dip containment region within a curved region of the snack.²¹

Applicants therefore respectfully assert that Hreschak '070 teaches away from Applicants' snack piece since a flattened snack piece without a dip containment region within a curved region of the snack operates counter to Applicants' curved dip containment region, and

¹⁹ 37 CFR § 104(d)(2); MPEP 2144.03.

²⁰ *Id.*

²¹ U.S. Design Patent No. 212,070 (Hreschak), Figure 4.

one of skill in the art looking at Hreschak '070 would not be motivated to produce Applicants' curved chip from Hreschak's flattened chip.

Also, Applicants point that Claims 10, 11 and 15 depend upon Claim 1. Claim 1 recites a stackable snack piece of which Hreschak '070 is not. In fact, Applicants contend that due to Hreschak's pinched end, it would be impossible to stack the snack pieces thereof. In addition, since the Examiner asserts that Hreschak '070 is stackable, and Hreschak '070 does not itself teach that element, Applicants believe that the Examiner's assertion of stackability derives wholly from his personal knowledge.

Therefore, Applicants respectfully request that the Examiner provide an affidavit that produces one or more references that supports the Examiner's assertions; i.e., 1) the stackability of Hreschak '070 and 2) the use of an engagement span calculation to Hreschak '070. If Applicants traverse an assertion made by the Examiner, the Examiner should cite a reference in support of his position.²² When a rejection is based on facts within the personal knowledge of the Examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the Applicant, by an affidavit from the Examiner.²³ If the Examiner fails to provide a suitable affidavit that bolsters his reasons for rejection herein, the rejection should be withdrawn.

Thus, Applicants respectfully request reconsideration and allowance of Claims 10-11 and 15 over the Examiner's 35 U.S.C. § 103(a) rejection.

Claims 5-7 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hreschak '070 in view of Blish [Des. 166,524].

Applicants believe that the combination of Hreschak '070 in view of Blish '524 is improper.

As noted herein previously, Applicants respectfully contend that the design of Hreschak '070 teaches away from Applicants' stackable snack piece because it would be physically impossible to stack the combined snack piece of Hreschak/Blish due to one end being pinched and elevated above the surface of the snack piece, i.e., the pinched end of Hreschak '070 defeats stackability and one of skill in the art looking at Hreschak '070 would be motivated against making a stacked snack piece like Applicants.

Also, as noted previously, the stackability of Hreschak '070 is improper, unfounded within the reference itself, and therefore resident only within the personal knowledge of the

²² 37 CFR § 104(d)(2); MPEP 2144.03.

²³ Id.

Examiner. Applicants therefore respectfully request an affidavit from the Examiner citing the references to which the Examiner refers when asserting the stackability of Hreschak '070 in combination with Blish '524. If the Examiner fails to provide a suitable affidavit that bolsters his reasons for rejection herein, the rejection should be withdrawn.

Hence, Applicants respectfully request reconsideration and allowance of Claims 5-7 and 23 over the Examiner's 35 U.S.C. § 103(a) rejection.

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hreschak '070 in view of Ipema [Des. 300,199].

As noted herein previously, Applicants respectfully contend that the design of Hreschak '070 teaches away from Applicants' snack piece for all of the reasons noted hereinbefore. Such teaching away is not cured by the combination of Hreschak '070 with Ipema '199, because Hreschak's teaching away from Applicants' invention removes it as a viable reference in any obviousness rejection, singly or in combination with any other reference.

Also, as noted previously, the stackability of Hreschak '070 is improper, unfounded within the reference itself, and therefore resident only within the personal knowledge of the Examiner. Applicants therefore respectfully request an affidavit from the Examiner citing the references to which the Examiner refers when asserting the stackability of Hreschak '070 in combination with Ipema '199. If the Examiner fails to provide a suitable affidavit that bolsters his reasons for rejection herein, the rejection should be withdrawn.

Applicants therefore request reconsideration and allowance of Claim 18 over the Examiner's 35 U.S.C. § 103(a) rejection.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hreschak '070 in view of Biershenk '606.

As noted herein previously, Applicants respectfully contend that the design of Hreschak '070 teaches away from Applicants' snack piece for all of the reasons noted hereinbefore. Such teaching away is not cured by the combination of Hreschak '070 with Biershenk '606, because Hreschak's teaching away from Applicants' invention removes it as a viable reference in any obviousness rejection, singly or in combination with any other reference.

Also, as noted previously, the stackability of Hreschak '070 is improper, unfounded within the reference itself, and therefore resident only within the personal knowledge of the Examiner. Applicants therefore respectfully request an affidavit from the Examiner citing the references to which the Examiner refers when asserting the stackability of Hreschak '070 in

combination with Biershenk '606. If the Examiner fails to provide a suitable affidavit that bolsters his reasons for rejection herein, the rejection should be withdrawn.

Applicants therefore request reconsideration and allowance of Claim 8 over the Examiner's 35 U.S.C. § 103 rejection.